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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/273,164 03/19/99 ROBERTS

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EXAMINER

HM22/0910

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HOUSTON TX 77210-4433

COOK, I

ART UNIT

PAPER NUMBER

1641

12

DATE MAILED:

09/10/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/273,164

Applicant(s)

ROBERTS ET AL.

Examiner

Lisa V. Cook

Art Unit

1641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 30-35 and 51-183 is/are pending in the application.
- 4a) Of the above claim(s) 35 and 51-181 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-14, 30-35 and 51-183 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Amendment Entry

1. Applicant's response to the Office Action mailed 15 December 2000, Paper #8 is acknowledged. In Amendment-B filed therein claim 9 was canceled without prejudice or disclaimer. Claims 1 and 10-14 were amended, while new claims 182 and 183 were added. Currently claims 1-14, 30-34, and 182-183 are under consideration. The new claims include sequence identification numbers (25, 27-30, 32, 40, 42, 44, 46, 48, 50, 52, 54, and 56) to further characterize the bovine PAG utilized in the method to detect pregnancy. The newly introduced limitations have necessitated the following restriction requirement.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- A. Claims 1-14, 30-34, and 182-183 are drawn to methods for detecting pregnancy in bovine animals utilizing BoPAG 2 (SEQ ID NO:25), classified in class 436, subclass 65 for example.
 - B. Claims 1-14, 30-34, and 182-183 are drawn to methods for detecting pregnancy in bovine animals utilizing BoPAG 4 (SEQ ID NO:27), classified in class 436, subclass 65 for example.
 - C. Claims 1-14, 30-34, and 182-183 are drawn to methods for detecting pregnancy in bovine animals utilizing BoPAG 5 (SEQ ID NO:28), classified in class 436, subclass 65 for example.

- D. Claims 1-14, 30-34, and 182-183 are drawn to methods for detecting pregnancy in bovine animals utilizing BoPAG 6 (SEQ ID NO:29), classified in class 436, subclass 65 for example.
- E. Claims 1-14, 30-34, and 182-183 are drawn to methods for detecting pregnancy in bovine animals utilizing BoPAG 7 (SEQ ID NO:30), classified in class 436, subclass 65 for example.
- F. Claims 1-14, 30-34, and 182-183 are drawn to methods for detecting pregnancy in bovine animals utilizing BoPAG 9 (SEQ ID NO:32), classified in class 436, subclass 65 for example.
- G. Claims 1-14, 30-34, and 182-183 are drawn to methods for detecting pregnancy in bovine animals utilizing BoPAG 7v (SEQ ID NO:40), classified in class 436, subclass 65 for example.
- H. Claims 1-14, 30-34, and 182-183 are drawn to methods for detecting pregnancy in bovine animals utilizing BoPAG 9v (SEQ ID NO:42), classified in class 436, subclass 65 for example.
- I. Claims 1-14, 30-34, and 182-183 are drawn to methods for detecting pregnancy in bovine animals utilizing BoPAG 15 (SEQ ID NO:44), classified in class 436, subclass 65 for example.
- J. Claims 1-14, 30-34, and 182-183 are drawn to methods for detecting pregnancy in bovine animals utilizing BoPAG 16 (SEQ ID NO:46), classified in class 436, subclass 65 for example.

- K. Claims 1-14, 30-34, and 182-183 are drawn to methods for detecting pregnancy in bovine animals utilizing BoPAG 17 (SEQ ID NO:48), classified in class 436, subclass 65 for example.
 - L. Claims 1-14, 30-34, and 182-183 are drawn to methods for detecting pregnancy in bovine animals utilizing BoPAG 18 (SEQ ID NO:50), classified in class 436, subclass 65 for example.
 - M. Claims 1-14, 30-34, and 182-183 are drawn to methods for detecting pregnancy in bovine animals utilizing BoPAG 19 (SEQ ID NO:52), classified in class 436, subclass 65 for example.
 - N. Claims 1-14, 30-34, and 182-183 are drawn to methods for detecting pregnancy in bovine animals utilizing BoPAG 20 (SEQ ID NO:54), classified in class 436, subclass 65 for example.
 - O. Claims 1-14, 30-34, and 182-183 are drawn to methods for detecting pregnancy in bovine animals utilizing BoPAG 21 (SEQ ID NO:56), classified in class 436, subclass 65 for example.
3. The inventions are distinct, each from the other because of the following reasons:
- I. Inventions A-O are drawn to a plurality of disclosed patentably distinct inventions (methods identifying polypeptides comprising materially different amino acid sequences as evidence by separate SEQ ID Numbers). The separate polypeptides bear distinct structural or biochemical properties as substantiated by the separate SEQ ID numbers and having different binding epitopes for unique diverse antibodies as defined in the disclosure (See page 34, Antigen

compositions). **Therefore, each disclosed patentably distinct polypeptide is considered a separate invention.**

Because, the inventions of Group A-O include a plurality of disclosed patentably distinct inventions (materially different substances as evidence by their separate SEQ ID Numbers). Therefore, each disclosed patentably distinct sequences/compositions and is considered a separate invention. Applicant is required to elect one Seq. Id. No. for prosecution in the instant application. 1232 OG 242 (116) 3/21/00. The O.G. Notice permits the examiner to examine up to ten nucleotide sequences per application based on use of US PTO resources. Resources are now stretched to the limit, so only one sequence should be searched per application.

Thus methods detecting the separated inventions are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the diverse inventive methods have different modes of operation identifying different compositions with separate sequences requirements. This distinction renders each method detecting the separate polypeptides patentably independent possibly having different modes of operation, different functions, or different effects because the methods utilize materially different products.

It is recognized that although the search for the inventions may overlap they are not totally co-extensive, where by the search for one would fully encompass the search for the others. Because these inventions are distinct for the reasons given above and the search required for Inventions A-N are not mutually inclusive restriction for examination purposes as indicated is proper.

4. The inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. Please note that the classifications in the restriction are illustrative only and **do not** represent all the classes and subclasses which must be searched for each invention; nor is the search limited to issued US patents, but rather includes foreign patents and applications as well as literature searches.

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).


7. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO fax center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Group 1641 Fax number is (703) 308-4242, which is able to receive transmissions 24 hours/day, 7 days/week.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa V. Cook whose telephone number is (703) 305-0808. The examiner can normally be reached on Monday - Friday from 7:00 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le, can be reached on (703) 305-3399.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Lisa V. Cook
Patent Examiner
Art Unit 1641
TMI-7-B17
29 August 2001


LONG V. LE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1800
09/27/01